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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.      | CONFIRMATION NO. |
|--|-------------|----------------------|--------------------------|------------------|
| 10/749,006   | 12/30/2003  | Ellen Lasch          | 37355-169                | 8389             |
| 7590   | 10/19/2005  |                      | EXAMINER<br>MAI, THIEN T |                  |
| John G. Bisbikis<br>McDermott, Will & Emery<br>227 West Monroe<br>Chicago, IL 60606-5096 |             |                      | ART UNIT<br>2876         | PAPER NUMBER     |

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

*FE*

|                              |                        |  |                     |  |
|------------------------------|------------------------|--|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> |  | <b>Applicant(s)</b> |  |
|                              | 10/749,006             |  | LASCH ET AL.        |  |
|                              | <b>Examiner</b>        |  | <b>Art Unit</b>     |  |
|                              | Thien T. Mai           |  | 2876                |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 September 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| <p>1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br/>Paper No(s)/Mail Date _____.</p> | <p>4) <input type="checkbox"/> Interview Summary (PTO-413)<br/>Paper No(s)/Mail Date. _____.</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6) <input type="checkbox"/> Other: _____.</p> |
|--|--|

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election of Group I containing claims 1-25 in the reply filed on 9/6/2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 24 recites the limitations "the pocket" and "the fill panel". There is insufficient antecedent basis for these limitations in the claim. Examiner suggests typo error may have been involved and therefore interpreted the claim as dependent upon claim 23 which mentions the limitations in question.

### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claim(s) 1-14, 20, and 22 rejected under 35 U.S.C. 102(e) as being anticipated by Conner (20050194453)

Regarding claim(s) 1-8, and 11, Conner discloses a transaction card comprising:

- a first layer of metal position at bottom of the transaction card (Specification par. 0011);

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- a recordable medium for storing information such as a chip 11 (Fig. 1) circular disk (Fig. 27-29) or magnetic strip affixed to the back the card (Specification par. 0011), inherently implies being disposed on the first layer of the metal;
- a second plastic layer comprising of two layers upper and middle (Specification par. 0011), adjacent and laminated to the metal layer (Specification par. 0079), which is made of PVC (Specification par. 0070), known in the art as thermoplastic polyvinyl material (see also Haghiri-20040099745, paragraph 0026);

wherein the metal layer is made of titanium (Specification par. 0076) or 300 series stainless steel (Specification par. 0070, 0076), which is on the bottom (Specification par. 0011) of the card and thus provides a surface for the transaction card.

Regarding claim(s) 9 and 13, Conner discloses the magnetic strip is affixed to the back of the card, inherently implies the affixation is adjacent to the metal layer. Conner further mentions an affixation is accomplished by glue (Specification par. 0072), which inherently implies an adhesive layer being deposited already in order to glue/affix the stripe. See also Roberts (US Patent 6,025,283) in regard to the inherency.

Regarding claim(s) 10, 12, and 14, Conner discloses all layers of the transaction card can alternately be made all of titanium layers or alloys or other metals (Specification par. 0076). As the result, the middle layer 33 or 6, interpreted as being the first layer of metal, is adjacent to the bottom being the second layer of substrate and the second layer is already proven in claim 9 for having an adhesive layer onto which the magnetic stripe is affixed (see discussion regarding claim 9).

Regarding claim(s) 20, Conner discloses the metal layers further include a cavity in which a chip 11 is embedded (Fig. 12).

Regarding claim(s) 22, Conner discloses the layers making up the transaction card can alternately be made all of titanium layers or alloys or other metals (Specification par. 0076) and the thickness of the

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card is desired to be compliant with ISO-7816 standard thickness of .031 inches (or 30 mils) (Specification par. 0068-69). Accordingly, the total thickness of the metal layer of the card in this embodiment is about 30 mils thick.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim(s) 15-17 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Conner (20050194453) in view of Kaminsky (20040121257).

Regarding claim(s) 15-17, Conner discloses all limitations set forth in this claim as discussed above except a surface coating that is made of polyethylene terephthalate material and comprises a dye for providing color to the card. Kaminsky discloses a transaction card with a metal layer 16 coated on the surface with a colored dye donor layer made of polyethelene terephthalate (Specification par. 0078, 0091). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the color dye of Kaminsky into Conner's invention with the motivation for the desire for manufacturing cards with different colors for different financial institutions.

8. Claim(s) 18-19 and 23-24 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Conner (20050194453) in view of Roberts (6025283) and in further view of Makishima (3468046) and Biller (20030150762).

Regarding claim(s) 18-19, Conner discloses all limitations set forth in this claim as discussed above except for a pattern being etched into the surface of the metal layer by a laser beam. Roberts discloses a card with laser-etched brand name as the pattern on its gold layer before applying a coating on

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top (col. 4 lines 42-57). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate Roberts' teaching with the motivation for the desire to have a card that yields more quality engraving or embossing using laser-etching techniques.

Regarding claim(s) 23, Roberts discloses a card having a recessed pocket from which embossed characters are protruded by the embossing process so that the thickness of the card conforms with ISO standard thickness. See the following text:

"Advantageously, to conform with ISO standards, the card can be milled out to provide a recess of 600 micron to accommodate SMART card technology and can thereafter be embossed." (col. 4 lines 46-49)

Conner-Roberts combination still fails to teach or reveal a filler panel being disposed within the pocket. However Makishima discloses card having a light filter 3 with translucent film 4, made so that the signature is invisible light in the visible spectrum but visible under ultraviolet light, is inserted to fill the pocket having indicia such as character signature in it (col. 3 lines 33-60). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to use a fill panel such as of Makishima with the motivation for the desire for further security for the transaction card.

Regarding claim(s) 24, Conner-Roberts-Makishima together still fails to teach an adhesive layer being disposed within the pocket to adhere the fill panel covering indicia. However, Biller discloses a label, interpreted as the fill panel, is used to adhere using adhesive material and cover indicia on the card (see Abstract). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention use a fill panel such as of Biller's to cover indicia such as account number or signature area for security protection purposes.

9. Claim(s) 21 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Conner (20050194453) in view of Hinata (20030202151).

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Regarding claim(s) 21, Conner discloses all limitations set forth in this claim as discussed above except an oxide layer on a surface of the metal layer being formed from an anodizing process.

Hinata discloses such technique is known in the art. See reference text below:

“The insulator 66 is fabricated of tantalum oxide (Ta.sub.2O.sub.3) that is obtained by oxidizing the first metal layer 65 through anodizing. When the first metal layer 65 is anodized, the surface of the first layer 79a of the line wiring 79 is also oxidized.

Similarly, a second layer 79b fabricated of tantalum oxide is thus formed.”

(Specification par. 0133)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to utilize anodizing technique to achieve bonding thus preventing the metal layer from peeling off.

10. Claim(s) 25 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Conner (20050194453) in view of Hara (US Patent 4,876,441, Hara'441 hereafter)

Regarding claim(s) 25, Conner discloses all limitations set forth in this claim as discussed above except for the transaction card to have chamfer edges around the perimeter of the card. Hara'441 discloses chamfering edges are provided around the perimeter for protection of the core portion which houses peripherals (col. 11 lines 11-35, Fig. 17). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to be motivated to utilize Hara's invention to further protect the electronics inside such as chip and to avoid incidents caused by sharp and non-chamfered edges.

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien T. Mai whose telephone number is 571-272-8283. The examiner can normally be reached on Monday through Friday, 8:00 - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thien T Mai  
Examiner  
Art Unit 2876

TM



**THIEN M. LE  
PRIMARY EXAMINER**